



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/815,229	03/30/2004	Michael Frederick Kenrich	2222.5490000	8114
26111 7590 11/13/2008 STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005				
EXAMINER				
ABEDIN, SHANTO				
ART UNIT		PAPER NUMBER		
2436				
MAIL DATE		DELIVERY MODE		
11/13/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/815,229

Applicant(s)

KENRICH ET AL

Examiner

SHANTO M. ABEDIN

Art Unit

2436

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 033333 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 October 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 July 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-8508)
- Paper No(s)/Mail Date 10/23/2008
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This office action is in response to the communication filed on 10/23/2008.
2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(c), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(c) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 07/14/2008 and 10/23/2008 have been entered.
3. Claims 1-26 are pending in the application.
4. Claims 1- 26 have been rejected.

Information Disclosure Statement

5. The information disclosure statement (IDS) submitted on 10/23/2008 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Response to Arguments

6. The applicant's arguments regarding the 35 USC 102 (e) type rejections of claims 1-25 are fully considered, however, found not persuasive. Regarding the 35 USC 102 (e) type rejections of claims 1-25, the applicant primarily argues that cited reference Ryan fails to disclose assigning a document retention policy to the electronic document, the document retention policy being derived from a periodic- installment retention schedule specifying respective installment periods, each of the respective installment periods having a respective document retention duration.

However, the examiner respectfully disagrees with the applicant on above arguments since upon further examination, the reference Ryan was found to teach the limitations assigning a document retention policy (Fig 3 A; Par 037-038, 046, 051-053; policy associated with the time based access restriction) to the electronic document, the document retention policy being derived from a periodic- installment retention schedule specifying respective installment periods, each of the respective installment periods having a respective document retention duration (Fig 3 A; Par 0037-0038, 0051-0053; policy associated with the time based access restriction; user having one or more keys associated with the predetermined time; a new time based access, or retention).

Therefore, previous 35 USC 102 (e) type rejections of claims 1-7 and 10-25 are maintained. The examiner notes, upon further examination, previous 35 USC 102 (e) type rejections of claims 8-9 in view of Ryan are withdrawn.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 1-26 are provisionally rejected under the judicially created doctrine of obviousness type double patenting as being unpatentable over claims 1-3 and 9-38 of copending application no. 10/815251.

In particular, claims 1-12 and 21-24 of the instant application are unpatentable over claims 1-3, 9-11 and 29-37 of the copending application 10/815251; and claims 13-20 and 25-26 are unpatentable over claims 1-3, 9-28 and 33-36 of the copending application 10/815251.

Although the conflicting claims are not identical, they are not patentably distinct from each other because all the claimed elements/features of the instant application exist in claim-set of the copending application in similar or different names, essentially performing same tasks.

Difference between the conflicting claims of the instant application and the conflicting claims of the copending application is that the conflicting claim set of the instant application are recited over the one or more claims of the copending application. Furthermore, while copending application claim set recites “retention policy” as specifying data retention period based on future scheduled event, the instant application recites the “retention policy” in terms of retention schedule.

However, at the time of invention, it would have been obvious to a person of ordinary skill in the art to design a method/ system wherein features are described differently in order to provide an alternative embodiment for the claimed invention.

This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

Art Unit: 2436

8. Claims 1-26 are provisionally rejected under the judicially created doctrine of obviousness type double patenting as being unpatentable over claims 1-28 of copending application no. 10/676850.

Although the conflicting claims are not identical, they are not patentably distinct from each other because all the claimed elements/features of the instant application exist in claim-set of the copending application in similar or different names, essentially performing same tasks.

Difference between the conflicting claims of the instant application and the conflicting claims of the copending application is that the conflicting claim set of the instant application are recited over the one or more claims of the copending application. Furthermore, while conflicting claims of the copending application claim set recite “access restrictions”, the instant application claim set recites such restrictions as part of retention policies.

However, at the time of invention, it would have been obvious to a person of ordinary skill in the art to design a method/ system wherein features are described differently in order to provide an alternative embodiment for the claimed invention.

This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

9. Claims 1, 3-6 and 21-25 are rejected under 35 USC § 101 since the claimed invention is directed to non-statutory subject matter.

Regarding claims 1 and 3-6, they are directed to a method. *However*, the languages seem to direct merely to an abstract idea which would not result in a practical operation, or producing a concrete, useful, and tangible result to form the basis of statutory subject matter under 35 U.S.C. 101. In particular, claim steps such as associating, or assigning, or imposing merely discloses the claimed features, but, fail to disclose what exact practical result (if any) was obtained at the end. Therefore, claimed invention is rejected under 35 USC 101 as fail to disclose any practical result at the end. MPEP 2106.01 [R-5].

Regarding claims 21-25, they are directed to medium, or system. *However*, claim languages fail to disclose any associated computer hardware, or structures. Furthermore, according to the specification (please see Par 103), such medium could be carrier wave, and such system could optionally be implemented in software only. Furthermore, a “key store” set forth by claim 25 fails to constitute a physical or computer storage device (such as a computer memory) since according to the specification (please se Par 043), such key store could be a software implemented table, or database, or file storage. Therefore, claimed invention is rejected under 35 USC 101 as being non-statutory. MPEP 2106.01.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

10. Claims 1-26 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the

Art Unit: 2436

relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim limitations such as “the document retention policy being derived from a periodic- installment retention schedule specifying respective installment periods, each of the respective installment periods having a respective document retention duration”, or “the retention access key being usable for said encrypting during an installment period of a periodic-installment retention schedule”, or “the retention policy having a respective document retention duration and a respective installment period” were not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

11. Claims 1-7 and 10 -26 are rejected under 35 USC 102 (e) as being anticipated by Ryan (US 2005/ 0071657 A1).

Regarding claim 1, Ryan discloses a method of providing automated document retention for an electronic document comprising:

(a) assigning a document retention policy to the electronic document [Fig 4; Fig 7; Par 037-038, 051-053; access restrictions/ policies/ rules/ security info] , the document retention policy being derived from a periodic- installment retention schedule specifying respective installment periods, each of the respective installment periods having a respective document retention duration [Fig 4, Fig 5; Par 037-038, 046, 051-053; policy associated with the time based access restriction; requiring a new time based restrictions/ rules/ keys for retention, or access to the document; each new retention key would have an associated specific predetermined/ future/ new time period that could be interpreted as recurred or installment schedule; therefore, Ryan teaches enablement of the document retention policy being derived from a periodic- installment retention schedule] and

(b) cryptographically associating the document retention policy with the electronic document

[Par 029, 037-038, 051-053; policy associated with the time based access restriction; time based access or retention restriction/ policy and key for each document]

Regarding claim 10, it is rejected applying as above rejecting claim 1, furthermore, Ryan discloses a method comprising:

determining whether an installment period for a current or prior document retention key has been reached [Fig 3A; Fig 5; Par 037, 038, 051, 053; determining whether time based access/ retention key is expired, or whether current time is greater than the predetermined retention/ access time];

generating a next document retention key to be used to encrypt an electronic document during a next installment period, the next document retention key having a document retention

Art Unit: 2436

duration associated therewith [Fig 4 and Fig 5; Par 037, 038, 051-053; time based access to the document, and new time based access key]; and

notifying a clients of the next document retention key [Par 051, 053]

Regarding claim 13, it is rejected applying as above rejecting claim 1, furthermore, Ryan discloses a method for restricting access to an electronic document, said method comprising:

encrypting the data portion of the electronic document using the document key to produce an encrypted data portion [Fig 4, 7; Par 047-051; encrypting/ securing the document];

using a retention access key to associate document retention policy on the electronic document [Par 013, 0017, 051-053, 065; time based restrictions/ policy, and key; new time based access key; expiring predetermined access];

encrypting the document key using the retention access key to produce an encrypted document key [Fig 3B; Par 037-038, 047, 053; expiring predetermined retention/ access time, and using a new time based access key; encrypting the document with a predetermined/ new time based access/ encryption key], the retention access key only being usable for said encrypting during an installment period of a periodic installment retention schedule [Fig 3B; Par 037-038, 046, 051-053; policy associated with the time based access restriction; user having one or more keys associated with the predetermined time; requiring a new time based key for retention/ access to the document; each new retention key would have a specific predetermined/ future/ new time period associated with that can be interpreted as recurred or installment retention schedule]

Art Unit: 2436

forming a secured electronic document from at least the encrypted data portion and the encrypted document key [Fig 4, 7; Par 047, 051-053; encrypted or securing the document]; and
storing the secured electronic document [Par 047-051].

Regarding claim 16, it is rejected applying as above rejecting claim 1 and 13, furthermore, Ryan discloses a method for accessing a secured electronic document by a requestor, the secured electronic document having at least a header portion and a data portion, said method comprising:

obtaining a retention access key, the retention access key being used to associate a document retention period of a document retention policy on the electronic document, the retention access key being usable only during the document retention period following a respective installment period of a recurring periodic installment retention schedule

[Par 037-038, 046, 051-053; policy associated with the time based access restriction; user having one or more keys associated with the predetermined time; requiring a new time based key for retention/ access to the document; each new retention key would have a specific predetermined/ future/ new time period associated with that can be interpreted as recurred or installment retention schedule; therefore, Ryan's above teachings suggests the document retention policy being based on a recurring installment retention schedule]

obtaining an encrypted document key from the header portion of the secured electronic document [Fig 4, 7; Par 047-053; encrypting or securing the document with the retention key obtained from each document/ header];

decrypting the encrypted document key using the retention access key to produce a document key [Par 047-053; decrypted document];

decrypting an encrypted data portion of the secured electronic document using the document key to produce a data portion [Par 047-053].

Regarding claims 21 and 25-26, they recite the limitations of claims 10 and 13-20, therefore, they are rejected applying the same rationale as applied to reject claims 10, 13-20. Furthermore, Ryan discloses a key store [Fig 1; key store] that stores a plurality of cryptographic key pairs, each of the cryptographic key pairs including a public key and a private key, at least one of the cryptographic key pairs pertaining to a retention policy, the retention policy having a respective document retention duration and a eat-off respective installment period [Par 037-038, 046, 051-053; policy associated with the time based access restriction; user having one or more keys associated with the predetermined time; requiring a new time based key for retention/ access to the document; each new retention key would have a specific predetermined/ future/ new time period associated with that can be interpreted as recurred or installment retention schedule; therefore, Ryan's above teachings suggests the document retention policy being based on a recurring installment retention schedule];

Regarding claim 2, it is rejected applying as above rejecting claim 1, furthermore, Ryan discloses the method further comprising: (c) cryptographically preventing access to the electronic document in accordance with the document retention policy when the document retention period for the electronic document has been exceeded [Par 016, 038, 051-053; exceeding/ expiring predetermined time; time based policy/ access].

Regarding claim 3, it is rejected applying as above rejecting claim 1, furthermore, Ryan discloses wherein step (b) utilizes a cryptographic key to impose the document retention policy, and wherein the document retention policy specifies a document retention period and a installment period [Fig 3B; Par 027, 037-038, 051-053; time based access to the document and key; expiring predetermined retention/ access time].

Regarding claim 4, Ryan discloses a method as recited in claim 3, wherein the document retention policy specifies a document retention period that expires a predetermined period of time after the respective installment period [Par 029, 037-038, 053, 065; policy associated with the time based access restriction; predetermined or new time slot associated with each time based retention key].

Regarding claim 5, Ryan discloses a method as recited in claim 3, wherein the respective installment period corresponds to a maximum off-line period of a client [Par 029, 037-038, 053, predetermined or new time slot associated with each time based retention key]

Regarding claim 6, Ryan discloses a method as recited in claim 1, wherein said imposing comprises acquiring a cryptographic key from a server over a network, the cryptographic key being used to associate the document retention policy [Fig 3A; Par 013, 017, 051, 065; policy associated with the time based access restriction; time based access/ retention key].

Regarding claim 7, it is rejected applying as above rejecting claim 1 and 6, furthermore, Ryan discloses a method as recited in claim 6, wherein said method further comprises: (c) deactivating the cryptographic key when respective document retention duration has expired, thereby preventing further access to the electronic document [Par 017, 046, 051; time based access key; expiring predetermined retention/ access time].

Regarding claim 17, Ryan discloses a method as recited in claim 16, wherein the retention access key is identified by an indicator within a header portion of the secured electronic document [Fig 7; obtaining document or file access key from header; Par 0047-0053; Claim 1-16].

Regarding claim 18, Ryan discloses a method as recited in claim 16, wherein the retention access key is a private retention access key [Fig 3A; Fig 7; header; file key; Par 047-053; private/ public key pair].

Regarding claims 11-12 and 22-24, they recite the limitations of claims 4-7, therefore, they are rejected applying as above rejecting claims 4-7.

Regarding claims 14-15 and 19-20, they recite the limitations of claims 4-6 and 17-18, therefore, they are rejected applying as above rejecting claims 4-6 and 17-18.

Conclusion

Art Unit: 2436

12. Examiner's note: Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may be applied as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

Finally, for any future amendments to claims, the applicant is respectfully suggested to incorporate the paragraph numbers from the specification upon which the support for such amendments were dependent on.

13. Applicant's A shortened statutory period for response to this action is set to expire in 3 (Three) months and 0 (Zero) days from the mailing date of this letter. Failure to respond within the period for response will result in ABANDONMENT of the application (see 35 U.S.C 133, M.P.E.P 710.02(b)).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shanto M Z Abedin whose telephone number is 571-272-3551. The examiner can normally be reached on M-F from 8:30 AM to 6:30 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Moazzami Nasser, can be reached on 571-272-4195. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. The RightFax number for faxing directly to the examiner is 571-273-3551.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Art Unit: 2436

Shanto M Z Abedin

Examiner, AU 2436

/Nasser G Moazzami/

Supervisory Patent Examiner, Art Unit 2436